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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,520	10/11/2001	Bettina Fath	101216-19	9360

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EXAMINER

CHANNAVAJJALA, LAKSHMI SARADA

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/975,520

Applicant(s)

FATH ET AL.

Examiner

Lakshmi S Channavajjala

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Receipt of amendment and response dated 6-24-04 and request letter dated 6-29-04 is acknowledged.

Claims 1-14 have been pending and new claims 15-18 have been added. Claims 1-18 are present.

The following rejection of record has been maintained:

Claim Rejections - 35 USC § 103

Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,851,544 to Penska et al (Penska) in view of US 6,328,950 to Franzke et al (Franzke).

Instant claim 1 is an aqueous hair composition, for imparting improved hair styling properties to hair, comprising at least one UV-absorbing substance, green tea extract and at least one mica/titanium dioxide (TiO₂) pigment, whereby at least 90% by weight thereof have a particle size between about 1 to about 250 microns. Claim 2 recites 80% to 90% of the pigment consists of mica and 10% to 20% of the pigment consists of TiO₂. Claim 3 recites mica/TiO₂ pigment in an amount of 0.05% to 5% by weight to the total weight of the composition. Claims 4 and 5 recite the UV absorbing compounds and their amounts from about 0.05% to 2.5%, by weight. Claims 7 and 8 recites amphoteric or zwitterionic surfactants in an amount of 0.1% to 5% by weight of the composition. Claim 9 recites 0.1% to 10% C₁₂-C₁₈ alkyl amidopropyl dimethyl or diethyl amine. Claims 10-14 are directed to a leave-in hair composition comprising the ingredients of claim 1.

Penska teaches a cosmetic composition comprising green tea extract, octyl methoxycinnamate, titanium dioxide, octyl methoxycinnamate and triethanolamine (see example 6 in col. 10). Penska teaches the composition for hair care or skin care and further teaches

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addition of surfactants such anionic, nonionic, zwitterionic surfactants. Penska clearly teaches that their compositions are suitable as leave-on as well as rinse-off compositions and for styling, tonics, conditioning hair (col. 5, lines 10-17). Among the surfactants, Penska mentions alkyl propanolamides such as cocomonoisopropanolamide, cocamidopropyl betaine etc (col. 5, lines 54-67). Penska teaches sunscreen agents such as TiO₂ or zinc oxide, but fails to teach the claimed Mica/TiO₂ particles.

Franzke teaches pigment containing hair styling gel compositions for hair-fixing, coloring the hair as well as imparting brilliant color, hold, shapability and lustrous appearance (col. 1), comprising at least one pigment, a thickener, water, surfactant and a polymer. Among the pigment particles suspended in the composition, Franzke teaches coated pigments such as TIMIRON (col. 3, lines 25-65, particularly lines 25-27 and 64), also employed in the examples of the instant application. Among the surfactants, Franzke teaches betaines as suitable amphoteric surfactants and thus read on claims 8-9 (col. 30-47). Further, Franzke teaches leave-on hair care composition, for producing the desired hair color and hairstyle (col. 8, lines 49-65). The examples of Franzke teach hair mousse preparation with the claimed amounts of TIMIRON (col. 9). Therefore, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to add TIMIRON (mica/TiO₂ pigments) of Franzke in the hair care compositions of Penska comprising green tea extract, octyl methoxycinnamate for leave-on hair coloring or styling effects because Franzke suggests that the pigment particle containing composition impart color to the hair without run off effects on the hair and impart a pleasant appearance, hold and shapability to the hair. Examiner notes that Instant specification also use the same trademark product TIMIRON and accordingly, the percentages of particles claimed are

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implicit to the product. Further, it would have been obvious for a skilled artisan to add the amphoteric surfactants, betaine, of Franzke in the composition of Penska and still expect the same emulsification. Furthermore, leaving the composition of Penska containing green tea extract, UV-B absorbing compound (of Penska) and TIMIRON and betaine of Franzke, on the hair without rinsing would have been obvious for a skilled artisan because Franzke suggests leaving the composition on hair and subsequent combing as needed results in the desired hold, shapability of the hair.

New claims 15-18 have also been rejected under this section. New claims specifically recite benzophenone and alkyl amidopropyl dimethyl amine. Penska teaches benzophenone compounds for protection from harmful UV rays and suggests alkyl amidopropyl betaines as amphoteric surfactants. Accordingly, it would have been obvious for one of a skilled artisan at the time of the instant invention to employ the claimed UV absorbing compounds and surfactants with an expectation to achieve UV protection as well as the desired emulsification.

RESPONSE TO ARGUMENTS:

Applicants' arguments regarding the previous rejections and unexpected results have been considered but not found persuasive.

Applicants argue that the unexpected results presented in the instant application have not been evaluated and that mere withdrawal of the rejection over a combination of Penska and Kurz is not in itself sufficient basis to ignore the discussion of unexpected results. Applicants also argue that Franzke, which only teach mica/titanium pigment particles as one of the hundreds of pigments, has been cited only to provide a basis of combining Penska's composition with

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mica/titanium pigment particles. Applicants argue that the mere recitation is insufficient for maintaining an obviousness rejection. Applicants' arguments are not found persuasive because both the references i.e., Penska and Franzke, teach compositions for hair care. In particular, Franzke not only teaches mica/titanium particles as one of the several pigments, but also teaches in hair care formulations (examples 1 and 2), which represent the best mode of practicing their invention. Thus, one of an ordinary skill in the art does not have to pick and choose mica/titanium particles from several pigments listed by Franzke. Instead, it would have been obvious for a skilled artisan to use mica/titanium particles (TIMIRON in examples) in hair compositions, as suggested by Franzke so as to achieve the desired hairstyle and color. Further, Franzke teaches that the compositions are useful for hairstyling, fixing, coloring, hold, and shapability, and also suggests applying the composition as a leave-on product and combed as needed (col. 8, lines 51-63).

Applicants further argue that the claimed composition has unexpectedly superior properties or unexpectedly improved properties, which are not present in the prior art. In support, applicants state that the examples 1 and 1A on page 11 of the instant specification show that composition comprising mica/TiO₂ particles provided a substantially superior hair styling properties in comparison to composition without the particles and that the superior results are attributed to the presence of mica/titanium particles, which was not disclosed by Penska or Franzke. However, as explained before, Franzke clearly exemplifies the claimed mica/titanium pigment particles and also in hair styling compositions. Franzke teaches that the composition impart hair shapability, style, luster, brightness, shine, holds and shapability. Further, while applicants argue that the instant composition produces unexpectedly superior results, examiner

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notes that instant claims are only limited to a hair composition for imparting hair styling, and does not require the argued unexpected properties to be present. Hence for the reasons provided above, the rejection has been maintained.

With respect to applicants' request, it is to be noted that Supervisor has reviewed the present action. Given the present generic claim, in comparison with the unexpected and superior results of example 1, it is noted that the results are not sufficient to establish a patentable distinction. There are no unexpected results given the fact that the prior art is directed to the same field of endeavor and solving the same problem. Prior art reference teaches improved hair styling and the claims as recited requires no more than this property. This indicates that consideration has been given to the scope of claims and also to the composition of example 1 of the instant application.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,


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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S Channavajjala whose telephone number is 571-272-0591. The examiner can normally be reached on 7.30 AM -4.00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Lakshmi S Channavajjala
Examiner
Art Unit 1615
November 5, 2004


THURMAN K PAGE
SUPERVISORY PATENT EXAMINER
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